

REMARKS

Applicant has carefully reviewed the Final Office Action of October 29, 2008, prior to preparing this paper. Currently claims 1-9, 11, 13-16, 19, 22-24, 26 and 30 are pending in the application, wherein claims 1-4, 8, 9, 11, 13-16, 19, 22-24, 26 and 30 have been rejected, and claims 5-7 have been withdrawn from consideration. Favorable consideration of the above amendments and following remarks is respectfully requested.

Claim Rejections Under 35 U.S.C. §102

Claims 1 and 11 were rejected under 35 U.S.C. §102(b) as being anticipated by Arenas, U.S. Patent No. 5,640,970. Applicant respectfully traverses this rejection.

Arenas teaches a guide wire having an elongated tapered core 22 having two coiled spring wires 28 and 36 disposed about the distal portion. Coil spring wire 28 has a general uniform diameter and extends from approximately reference 30 to distal end 34 as shown in Figure 2. Coiled spring wire 36 is attached to core 22 by coils 41 and 42, which are more tightly wound than coiled spring wire 36 as a whole. Moving in a distal direction from coils 41 and 42, coiled spring wire 36 expands to the diameter of coiled spring wire 28 and is interleaved with the coils of coiled spring wire 28, and extends to distal tip 34. Significantly for the purposes of this discussion, coils 41 and 42 are not a separate member, but rather are the distal portion of coiled spring wire 36.

When Arenas is properly understood, it can easily be seen that Arenas does not anticipate claims 1 and 11. For example, claim 1 recites "the elongated reinforcing member disposed about the proximal portion of the distal section such that the distal portion of the distal section is free of the reinforcing member." As the elongated reinforcing member is, in fact, coiled spring wire 36, which extends to distal tip 34, it can be seen that the distal portion of the distal section is not free of the reinforcing member. Claim 1 also recites "the outer coil member located exterior of the elongated reinforcing member such that there exists an unoccupied space between the entire perimeter of the elongated reinforcing member and the outer coil member." As the larger portion of coiled spring wire 36 is the same diameter as and interleaved with coiled spring wire 28, it cannot be said that, first, the outer coil member is located exterior of the elongated reinforcing

member or, second, that there exists an unoccupied space between the entire perimeter of the elongated reinforcing member and the outer coil member.

Because Arenas does not teach each and every element of independent claim 1, Applicant submits that claim 1 is in condition for allowance over Arenas. As claim 11 depends from claim 1 and contains additional elements, Applicant submits that claim 11 is likewise in condition for allowance.

Claims 2-4 were rejected under 35 U.S.C. §103(a) as being unpatentable over Arenas in view of O'Connor et al., U.S. Patent No. 6,887,235. Applicant respectfully traverses the rejection.

O'Connor is cited for teaching a reinforcing member with a helical grooves for the purpose of providing desired torque and flexibility characteristics to the reinforcing member without requiring additional components, but, so far as Applicant can tell, O'Connor et al. do not remedy the deficiencies of Arenas as discussed above. Arenas in view of O'Connor et al., therefore, does not disclose each and every element of independent claim 1, from which claims 2-4 depend. Because the cited references do not disclose or suggest each and every element of claims 2-4, no *prima facie* case of obviousness has been made, and Applicant respectfully submits that these claims are in condition for allowance.

Claims 8-9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Arenas in view of Palermo et al., U.S. Patent No. 5,769,796.

Palermo et al. are cited as teaching a guide wire having a portion with a non-circular cross section, but, so far as Applicant can tell, Palermo et al. do not remedy the deficiencies of Arenas as discussed above. Arenas in view of Palermo et al., therefore, do not disclose each and every element of independent claim 1, from which claims 8-9 depend. Because the cited references do not disclose or suggest each and every element of claims 8-9, no *prima facie* case of obviousness has been made, and Applicant respectfully submits that these claims are in condition for allowance.

Claims 13-16, 19, 22-24, 26 and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Vrba et al., U.S. Patent Pub. No. 2004/0122340 in view of O'Connor et al., U.S. Patent No. 6,887,235.

Under the provisions of 35 U.S.C. §103(c), Vrba et al. are not available as prior art. Vrba et al. published on June 24, 2004, after the filing date of September 22, 2003 of the present application, and is therefore only available as prior art under 35 U.S.C. §102 under the provisions of §102(e). Both the subject matter of Vrba et al. and of the present application were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

For at least the reason that Vrba et al. are not available as prior art under 35 U.S.C. §103, Applicant submits that these claims are in condition for allowance.

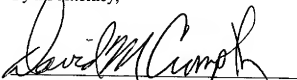
Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By his Attorney,

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